
OVERLAP BETWEEN TRADEMARKS AND DESIGNS

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ABSTRACT

This article attempts to focus on the two very significant branches of Intellectual Property Rights i.e., Trademarks and Designs and on the possible overlap between the two which is witnessed by the owners and producers of the goods or articles specifically having aesthetic relevance. The Article also tries to help the readers in order to understand and the producers in order to choose or rather to opt for the correct protection framework in case of an overlap by analysing various possible circumstances.

INTRODUCTION

A certain artistic creation, though it may be capable of being registered as design, may at times can also be capable of being applied as a trademark. A Trademark acts as source identifier with the help of which genuine products are sold in the market. On the other hand, a design is simply to be protected if at all it appears to the eyes having some aesthetic features which attracts the consumers and can subsequently be protected. Usually, there is no other purpose or function for which it is used.

Whereas, on the other hand, trademarks perform and operates in the market by associating itself with different sets of objectives altogether. Trademarks is a mark used in trade in order to distinguish the goods and services from that of the others present in market and also to maintain the genuineness and authenticity of the goods by acting as a source identifier. Moreover, another very significant reason for having a trademark protection is to minimize the scope of unfair competition in the market.

But, the definition of trademarks¹ has been constructed as such that it explicitly says that it will also include the shape of the goods, its packaging and combination of colours. Now these three features or rather characteristics are specifically distinct from what a Logo can traditionally be or a mark can traditionally be.

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These additions that has been made in the definition of trademarks and the abovementioned three characters which associates itself to the trademarks specifically shape of a particular good, its packaging and combination of colours are the features of a product that can also aesthetically appeal to the eyes. At the same time, features of an article or a product appealing to the naked eyes are the only predominant requisites of a design which can be registered under the respective statute and therefore, overlapping each other.

¹ The Trade Marks Act, 1999, § 2(1)(zb), No. 47, Acts of Parliament, 1999

For example, if the manufacturer of an article take combination of four to five pastel shades. This can give birth to a couple of questions such as, the fact that there are pastel shades put together in a certain article,

1. Will that not solely appeal to the eyes as a design because there are no other functions that it could perform?
2. Whether it should be called as a Design or a Trademark?

So, this combination is not essentially a mark applied to a product but its registration as a trademark has become a dispute because the combination of colours and specifically its entire packaging can also be a subject matter of a Trademark protection. These three features largely are something that may not necessarily be an affixation of a mark traditionally but subsequently has transformed itself to acquire the status of a trademark.

This has happened because of the inclusive definition of trademarks which goes on to include some characteristics or rather features which are also a part of Design protection. So, these three characteristics or rather features that are added may not necessarily be like traditional trademarks, rather they can be something that solely appeals to the naked eye and not necessarily can perform Trademark functions and therefore because of this, there occurs a possibility of overlap between the two.

WHICH ONE OFFERS BETTER PROTECTION?

Here the question arises that if there is a shape or a packaging to be applied to a product, should it be protected under Design protection framework or is it also capable of being registered under the trademark law?

Are these characteristics serving the purpose of a trademark that is to perform as a source identifier or, is it something which has nothing to do at all with the domain of trademarks? Or,

Whether it is helping the consumers to identify that, how good a manufacturer is based on only aesthetic features eventually can attract the consumers or not?

The purpose/function test answers the above question. Based on the utility of that specific function and the performance or rather the functionality of the same are the bullet points which must be investigated and accordingly anyone can clearly distinguish between the two as in where it must be protected. Therefore, no confusion can be made with regards to choosing the better protection framework as it totally depends on the aspects of functionality

But the problem arises in certain circumstances where, while attempting to enhance the aesthetic feature, sometimes what happens is that the consumer starts to associate the given design to a certain manufacturer or producer. As a result, the design as such is intended to only serve an aesthetic purpose, but because of the abovementioned reason now it has started to serve the function of a trademark.

This situation gives birth to the most significant or rather crucial decision which must be made by the manufacturer as to what will give a better entitlement in terms of rights, remedies or reliefs and also if at all, is it possible that someone can seek protection under both trademark as well as design framework?

Here, trademark protection is a better protection to opt for instead of design as no person would want to have a protection of 10 years which can be further extended to 5 more years as provided by the Designs Act. Moreover, the protection is limited and that to for a specific class of articles where one does not even have a criminal remedy available. Another solution could be that a manufacturer can start using design protection at the initial stages of the article being launched in the market, but trademark protection has always had the upper hand because of the extended protection at every phase.

But in a case where design has acquired so much distinctiveness in order for it to be considered as a trademark, then the solution can be that the manufacturer can seek for Trademark protection or can simply continue or retain the design protection because at the end of the day it was only aesthetics.

Another solution can be that one can also stick to the design protection for 10 years rather than waiting for another five years for the term to get over and after 10 years the manufacturer can go to the registrar and can apply for the registration of the trademark.

Therefore, the trademark protection has an edge over the design protection because of certain additional features such as-

- The trademark protection protects more features, offers perpetual protection subject to renewal.
- Provides for longer duration of protection.
- Provides for additional remedies i.e., Civil and criminal, the availability of passing off remedy.
- Provides for three categories of protection such as passing off remedy for unregistered trademarks and legal remedies in case of Well-Known trademarks and Registered trademarks.

CURRENT STAND OF THE INDIAN JUDICIARY

Mohan Lal Vs. Sona Paints & Hard wares²

In this judgement, of 2013, full bench of the Delhi High Court made it crystal clear that a design can very well be used as a trademark and moreover, the Court also held that a registered design which is being used as a trademark is also entitled for remedial measures in case of infringement.

Carlsberg Breweries Vs. Som Distilleries³

In this Judgement of 2019, five Judges bench of the Delhi High Court laid down a different view by saying that a registered design can be cancelled if it is being used as a trademark per se.

M/S Crocs INC USA Vs. M/S Bata & Others⁴

² Mohan Lal v. Sona Paint & Hard wares (2013) 55 PTC 61 (Del)

³ Carlsberg Breweries v. Som Distilleries 256 (2019) DLT 1

⁴ M/S Crocs INC USA Vs. M/S Bata & Others 2019 SCC On Line Del 6808

In this latest decision of 2019, the division bench of the Delhi High Court somewhat relied in the precedent as laid down in Mohan Lal's decision and the Court also granted interim relief to the plaintiff.